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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, JIMMY T

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,011

Applicant(s)

CORCORAN ET AL.

Examiner

Jimmy T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because: reference character “70” has been used to designate both “a rubber” (fig. 9) and “an end cap” (fig. 12); and reference character “72” has been used to designate both “a cutting pad” (fig. 9) and “an end cap” (fig. 12). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

The reference character “70” has been used to designate both “an end cap” (page 5, line 17) and “the rubber” (page 6, line 15); and reference character “72” has been used to designate both “an end cap” (page 5, line 17) and “the cutting pad” (page 6, line 17).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32-35, 40-47, 59 and 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 32, line 6, there is no antecedent basis for "the bearings" in the claim.

Regarding claim 40, line 1, there is no antecedent basis for "the cover" in the claim.

Regarding claim 42, line 1, there is no antecedent basis for "the cover" in the claim.

Regarding claim 59, line 2, there is no antecedent basis for "the cover" in the claim.

Regarding claim 60, line 2, there is no antecedent basis for "the center rail" in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,619,195.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Regarding claim 1, the claim recites “a die press, comprising: a base; opposing first and second supports extending from the base” (see lines 1-4 of claim 1 of the patent), “at least one cam member that is supported by the opposing supports” (see lines 5-6 of claim 1 of the patent), “means for rotating the cam member” (see line 7 of claim 1 of the patent), “at least one bearing located on the cam member” (see line 8 of claim 1 of the patent), “a platen positioned generally between the at least one bearing and the base” (see lines 9-10 of claim 1 of the patent), and “a cover being unitary with the platen, the cover being slidably engaged with the opposing supports to guide the platen during operation of the die press” (see lines 13-15 of claim 1 of the patent).

It is clear that all of the elements of claim 1 of the application are to be found in claim 1 of the patent. The difference between claim 1 of the application and claim 1 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 1 of the patent is in effect a “species” of the “generic” invention of claim 1 of the application. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d2010 (Fed. Cir. 1993). Since claim 1 of the application is anticipated by claim 1 of the patent, it is not patentably distinct from claim 1 of the patent.

Regarding the depending claims 2-23, all of the elements of the claims can be found in claims 2-22 of the patent.

Regarding claim 24, the claim recites “a die press, comprising: a base; opposing first and second supports extending from the base” (see lines 1-4 of claim 24 of the patent), “a cam member that is supported by the opposing supports” (see line 5 of claim 24 of the patent),

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“means for rotating the cam member” (see line 6 of claim 24 of the patent), “a plurality of bearings located on the cam member” ((see line 7 of claim 24 of the patent), “an upper platen positioned generally between the bearings and the base (see lines 8-9 of claim 24 of the patent), and “a cover being attached to the platen to define a unitary structure, the cover being slidably engaged with the opposing supports to guide the upper platen during operation of the die press and to resist torsional forces” (see lines 12-15 of claim 24 of the patent).

It is clear that all of the elements of claim 24 of the application are to be found in claim 24 of the patent. The difference between claim 24 of the application and claim 24 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 24 of the patent is in effect a “species” of the “generic” invention of claim 24 of the application. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d2010 (Fed. Cir. 1993). Since claim 24 of the application is anticipated by claim 24 of the patent, it is not patentably distinct from claim 24 of the patent.

Regarding the depending claims 25-31, all of the elements of the claims can be found in claims 25-31 of the patent.

Regarding claim 32, the claim recites “a die press, comprising: a base; at least two opposing supports extending from the base” (see lines 1-4 of claim 1 of the patent), “at least one cam member that is supported by the opposing supports (see lines 5-6 of claim 1 of the patent), “a handle extending from the cam member” (see line 2 of claim 12 of the patent), “and an upper platen positioned between the bearings and the base” (see claim 15 of the patent), “the base

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further including at least two rails extending from the base, the rails being adapted to support a die (see claims 18-20 of the patent).

It is clear that all of the elements of claim 32 of the application are to be found in claims 1, 11, 12, 15, and 18-20 of the patent. The difference between claim 32 of the application and claims 1, 11, 12, 15, and 18-20 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claims 1, 11, 12, 15, and 18-20 of the patent is in effect a “species” of the “generic” invention of claim 32 of the application. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d2010 (Fed. Cir. 1993). Since claim 32 of the application is anticipated by claims 1, 11, 12, 15, and 18-20 of the patent, it is not patentably distinct from claims 1, 11, 12, 15, and 18-20 of the patent.

Regarding the depending claims 33-35, all of the elements of the claims can be found in claims 19, 20 and 22 of the patent.

Regarding claim 36, the claim recites “the die press, comprising: a base; opposing first and second supports extending from the base” (see lines 1-4 of claim 1 of the patent), “at least one cam member that is supported by the opposing supports” (see lines 5-6 of claim 1 of the patent), “means for rotating the cam member” (see line 7 of claim 1 of the patent), “at least one bearing located on the cam member” (see line 8 of claim 1 of the patent), “a platen positioned generally between the at least one bearing and the base” (see lines 9-10 of claim 1 of the patent), and “a rail extending from the base” (see line 11 of claim 1 of the patent).

It is clear that all of the elements of claim 36 of the application are to be found in claim 1 of the patent. The difference between claim 36 of the application and claim 1 of the patent lies in

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the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 1 of the patent is in effect a “species” of the “generic” invention of claim 36 of the application. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d2010 (Fed. Cir. 1993). Since claim 36 of the application is anticipated by claim 1 of the patent, it is not patentably distinct from claim 1 of the patent.

Regarding the depending claims 37-61, all of the elements of the claims can be found in claims 1-23 of the patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36, 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brooks et al. (hereinafter “Brooks”) (US 3,926,032), in view of Kato (US 5,544,576).

Regarding claim 36, Brooks discloses a press comprising: a base (11), opposing supports extending from the base (fig. 1), a platen (12) positioned between a mechanical driven means and the base (fig. 2) and a rail (29) extending from the base. Brooks does not expressly disclose the mechanical driven means is a specific cam drive system as claimed. However, the patent to Kato teaches a press having a mechanical means comprising a cam member (15, 16) supported by opposing supports (fig. 1), means for rotating the cam member (20), and bearings (17, 18)

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located on the cam member, Kato teaches this cam drive system in order to drive a platen (7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the mechanical driven means of Brooks with the type of mechanical driven means (i.e. cam drive system) as taught by Kato, as such would be a mere substitution of ordinary mechanical expedient, in order to drive the platen.

Regarding claims 51 and 52, Brooks, as modified by Kato, discloses the rotation of the cam member provides for movement of the platen and forces are transferred from the cam member to the platen when the cam member is rotated.

Regarding claim 53, the platen is an upper platen (fig. 2).

Regarding claim 54, Brooks discloses mean for feeding (19, 20) a die (44) into a working area (14) between the platen and the base (fig. 1).

Regarding claim 55, Brooks discloses mean for feeding (19, 20) a shuttle (18) into a working area (14) between the platen and the base (fig. 1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 756,902 discloses a punching machine having a cam member (b6) supported by two opposing supports (b, D) and a handle (M) extending from the cam member, and an upper platen (b') positioned between bearings (b8, d8) and a base (A).

US 3,266,358 discloses a key punching machine.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy T. Nguyen whose telephone number is (571) 272-4520.

The examiner can normally be reached on Mon-Thur 8:00am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272- 4419. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JTNguyen
July 12, 2005



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